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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/997,966 | 11/29/2001 | Mark Parisi | 990164 | 4905 |

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT PAPER NUMBER

2686

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,966

Applicant(s)

Parisi

Examiner

Rafael Perez-Gutierrez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12, and 13 is/are rejected.
- 7) ☒ Claim(s) 5 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted on July 18, 2003 has been considered by the Examiner and made of record in the application file.

Drawings

2. The formal drawings filed on February 19, 2002 were approved by the Draftsperson.
3. The drawings are objected to because of the following minor informalities:
 - a) On **figure 1 item 188**, replace "LOAD" with --LOCAL-- in order to provide consistency with the description of the figure in **page 4 paragraph 0018 line 1**; and
 - b) On **figure 4 step 408**, replace "REGULATION" with --REGISTRATION-- in order to provide consistency with the description of the figure in **page 9 paragraph 0034 line 5**.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. If a response to the present Office Action fails to include proper drawing corrections, corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the objections/corrections to the drawings are no longer held in abeyance.

Claim Objections

5. **Claims 4, 7, 10, and 13** are objected to because of the following informalities:
- a) On **line 3** of **claims 4 and 10**, insert --and-- after "transmission"; and
 - b) On **line 2** of **claims 7 and 13**, replace "the" with --a-- before "mobile" in order to provide proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 7, 9, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by **Beasley (U.S. Patent # 6,055,426)**.

Consider **claims 1 and 6**, Beasley clearly shows and discloses a method for operating a mobile unit 12 (reporting module) (figures 1 and 2) to register with a platform 52 (monitoring facility) (figure 2) via a cellular (wireless) communications network 15 (abstract and figures 1 and 2), comprising operations of:

the mobile unit 12 (reporting module) (figures 1 and 2) determining whether or not wireless coverage is available via the cellular (wireless) network 15 by monitoring transmissions from said network 15 for a system identification number (SID) (coverage code) and upon receipt of the SID (coverage code), referencing a coverage record (e.g., stored in memory) to determine whether the received SID (coverage code) indicates that wireless coverage is available (abstract, figure 5A, column 1 lines 42-45 and 55-61, column 3 lines 21-30, column 11 lines 1-4 and 26-28, and column 13 lines 1-27);

if the coverage is determined to be available, the mobile unit 12 (reporting module) transmitting a present notification (registration request) at a first prearranged time (e.g., upon detecting an overhead message stream (OHMS)) (figure 5A, column 3 lines 40-58, and column 11 lines 4-6);

if coverage is determined to be unavailable, the mobile unit 12 (reporting module)

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refraining from transmitting the presence notification (registration request) (e.g., when the unit 12 is out of coverage, no presence notification is transmitted) (figure 5A and column 11 lines 6-17); and

if the coverage availability is unable to be determined, the mobile unit 12 (reporting module) transmitting an out of service notification (registration request) at a second prearranged time (e.g., when the unit 12 is powering down) (figure 5A, column 4 lines 45-55, column 10 lines 15-21, and column 12 lines 58-61).

Consider **claim 3**, and **as applied to claim 1 above**, Beasley further shows and discloses that responsive to receiving the notification (registration request) from the mobile unit 12 (reporting module), the platform 52 (monitoring facility) determining whether the mobile unit 12 (reporting module) determined coverage to be available by analyzing which of the first or second prearranged times (e.g., upon detecting out of coverage or out of service) the mobile unit 12 (reporting module) transmitted the notification (registration request) (figures 4 and 5A, and column 10 lines 15-30).

Consider **claim 4**, and **as applied to claim 3 above**, Beasley also shows and discloses that the operation of the mobile unit 12 (reporting module) transmitting notification (registration requests) further includes transmitting a time of transmission (column 10 lines 14-32); and

the operation of the platform 52 (monitoring facility) analyzing which of the first or second prearranged times the mobile unit 12 (reporting module) transmitted the notifications (registration request) upon comprises reviewing the time of transmission (column 10 lines 14-32).

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Consider **claims 7, 12, and 13**, Beasley clearly shows and discloses a data collection system, comprising:

a platform 52 (monitoring facility/means) in communication with a cellular (wireless) communications network and programmed to recognize received messages transmitted by a mobile unit 12 (reporting module) at first prearranged times to mean that the mobile unit 12 (reporting module/means) has deemed coverage by the network to be available, and to recognize received messages transmitted by the mobile unit 12 (reporting module/means) at second prearranged times to mean that the mobile unit 12 (reporting module/means) has deemed coverage by the network to be unknown (figures 1, 2, and 5A, column 3 lines 40-58, column 4 lines 45-55, column 10 lines 15-21, column 11 lines 4-6 and column 12 lines 58-61).

one or more mobile unit 12 (reporting module/means) including a clock 126 (figures 1-3) programmed to re-register with the platform 52 (monitoring facility/means) via a cellular (wireless) communications network 15 by performing operations comprising:

determining whether or not wireless coverage is available via the cellular (wireless) network 15 by monitoring transmissions from said network 15 for a system identification number (SID) (coverage code) and upon receipt of the SID (coverage code), referencing a coverage code history record (e.g., stored in memory) to determine whether the received SID (coverage code) indicates that wireless coverage is available (abstract, figure 5A, column 1 lines 42-45 and 55-61, column 3 lines 21-30, column 11 lines 1-4 and 26-28, and column 13 lines 1-27);

if the coverage is determined to be available, transmitting a present notification

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(registration request) upon one of the first prearranged time (e.g., upon detecting an overhead message stream (OHMS)) (figure 5A, column 3 lines 40-58, and column 11 lines 4-6);

if coverage is determined to be unavailable, refraining from transmitting the presence notification (registration request) (e.g., when the unit 12 is out of coverage, no presence notification is transmitted) (figure 5A and column 11 lines 6-17); and

if the coverage availability is unable to be determined, transmitting an out of service notification (registration request) upon one of the second prearranged time (e.g., when the unit 12 is powering down) (figure 5A, column 4 lines 45-55, column 10 lines 15-21, and column 12 lines 58-61).

Consider **claim 9**, and **as applied to claim 7 above**, Beasley further shows and discloses that the platform 52 (monitoring facility) is further programmed to, responsive to receiving the notification (registration request) from the mobile unit 12 (reporting module), the platform 52 (monitoring facility) determining whether the mobile unit 12 (reporting module) determined coverage to be available by analyzing which of the first or second prearranged times (e.g., upon detecting out of coverage or out of service) the mobile unit 12 (reporting module) transmitted the notification (registration request) (figures 4 and 5A, and column 10 lines 15-30).

Consider **claim 10**, and **as applied to claim 7 above**, Beasley also shows and discloses that the operation of the mobile unit 12 (reporting module) transmitting notification (registration requests) further includes transmitting a time of transmission (column 10 lines 14-32); and

the operation of the platform 52 (monitoring facility) analyzing which of the first or second prearranged times the mobile unit 12 (reporting module) transmitted the notifications

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(registration request) upon comprises reviewing the time of transmission (column 10 lines 14-32).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 2 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Beasley (U.S. Patent # 6,055,426)**.

Consider **claims 2 and 8**, and as applied to **claims 1 and 7** above, Beasley clearly shows and discloses the claimed invention except that the first prearranged times comprise an even minute past any hour and the second prearranged times comprise an odd minute past any hour.

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Nonetheless, specifying the first prearranged times to be even minutes past any hour and the second prearranged times to be odd minutes past any hour is just a matter of programming configuration, therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to specify the claimed times in the method and system taught by Beasley for the purpose of configuration.

Allowable Subject Matter

9. **Claims 5 and 11** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as well as any corrections to the objections made above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Evans et al. (U.S. Patent # 6,311,060 B1) disclose a method and system for registering the location of a mobile cellular communications device.

11. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents
P.O. Box 1450

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Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

220 S. 20th St.
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

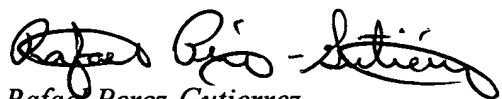
12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

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A handwritten signature in black ink, appearing to read 'Rafael Perez-Gutierrez', written in a cursive style.

Rafael Perez-Gutierrez

R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**
PATENT EXAMINER

September 28, 2004